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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,082	04/20/2001	David D'Arcy Clifford	T8466709US	2707

26912 7590 11/25/2003

GOWLING LAFLEUR HENDERSON LLP
COMMERCE COURT WEST, SUITE 4900
TORONTO, ON M5L 1J3
CANADA

EXAMINER

AFTERGUT, JEFF H

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 11/25/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

09/17

Office Action Summary

Application No.

09/839,082

Applicant(s)

CLIFFORD, DAVID D'ARCY

Examiner

Jeff H. Aftergut

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Clifford or PCT WO 00/48831 and any one of Japanese Patent 11-151530, Japanese Patent 11-347642 or Onat et al optionally further taken with either one of Japanese Patent 58-252216 or Kojima et al.

The references to either one of PCT '831 or Clifford suggested that it was known per se to join a pair of metal skins together with a paper core of resin impregnated paper material in order to manufacture a vehicle body panel. The applicant is more specifically referred to column 1, lines 15-21 of Clifford where the reference expressly states that the sheets were used in the manufacture of vehicle bodies. The reference suggested that the sheets were formed from paper webs which were impregnated with a resin and which were adhesively secured to the skins of metal having the specified thickness, see for example Table 1 and Table 2 for example. The reference suggested the specified materials for the metal skins as defined at column 6, lines 49-57. the applicant is advised that the reference to PCT '831 suggested that one skilled in the art would have known to form the panels from two skins of metal attached together with a core of resin coated paper wherein the same was useful as a vehicle panel, see page 1, lines 4-7. the reference suggested that one skilled in the art would have employed metal skins of the specified thickness see page 4, lines 13-18. the reference additionally suggested suitable paper materials similar to that claimed, see page 4, lines 20-23, for example. Neither reference to Clifford or PCT '831 suggested that those skilled in the art at the time the invention was made would have

Art Unit: 1733

incorporated a press to shape the panels to form a vehicle body part wherein one employed a die press to press the assembly to make the panel.

The references to any one of Japanese Patent 11-151530, Japanese Patent 11-347642 or Onat et al suggested that those skilled in the art at the time the invention was made would have understood that in the manufacture of a vehicle body part one skilled in the art would have shaped the panels via a die pressing operation in a mold. It should be noted that each of these references suggested that the panels would have been formed from metal sheet material which was disposed in a die press and subjected to shaping. The references to each of Clifford and PCT '831 suggested that those skilled in the art at the time the invention was made would have incorporated the paper between the metal facing sheets in order to produce a lightweight panel material which was less expensive than a single sheet of metal and which retained the same strength qualities of the single sheet of metal. It would have been obvious in the operation of forming a vehicle panel that these sheet materials would have been subjected to a die pressing operation to form the panels into the desired shape as useful as a vehicle body panel material as the references to PCT '831 and Clifford suggested the assemblies would have been useful as panel materials and the references to any one of Japanese Patent 11-151530, Japanese Patent 11-347642 or Onat et al suggested that the die press shaping was a common practice for shaping a metal sheet material into a vehicle panel. The applicant is additionally advised that it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the multilayer panels of either one of PCT '831 or Clifford in the operation of any one of Japanese Patent 11-151530, Japanese Patent 11-347642 or Onat et al as such would have afforded one with increased and/or equal strength at a reduction in manufacturing costs.

Art Unit: 1733

Regarding the specifics of the metal layer and the paper layer, the applicant is referred to the references to Clifford and PCT '831 for a discussion of the specified properties. It should be noted that it would have been within the purview of the ordinary artisan to select a suitable material to the metal as well as the paper impregnated sheet cores. It should be noted that the references suggested that the core paper were preimpregnated with resin and thus one would have understood such would have included heating to partially polymerize the resin (which would have resulted in a drying and removal of volatiles from the resin). Such is taken as conventional in the art of preimpregnating materials where the resins are partially cured. Regarding the specifics of the die, one skilled in the art would have understood that such was a function of the shape of the finished panel one wished to attain and it certainly would have been within the purview of the ordinary artisan to select a suitable shape as a function of the desired shape of the finished panel.

While the references do not expressly suggest that one skilled in the art would have known how to die press a multilayer assembly which included metal skins. The applicant is advised that those skilled in the art at the time the invention was made would have reasonably expected that the operation would have worked in light of the teachings to either one of Kojima or Japanese Patent 58-151216. more specifically, both suggested that it was known per se to employ a die press to press a multilayer assembly and join the layers together. Clearly, in light of the die press molding suggested by either one of Japanese Patent '216 or Kojima, one skilled in the art at the time the invention was made would have expected that the die pressing of the panel assemblies of PCT '831 or Clifford would have worked when pressing according to the techniques of any one of Japanese Patent 11-151530, Japanese Patent 11-347642 or Onat et al.

Art Unit: 1733

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,419,774 in view of either one of Clifford or PCT WO 00/48831. the applicant is advised that the reference to US Patent '774 in the claims clearly recites that one employ a die press to shape the non-planar laminate to form a panel having a non-planar shape. The references to Clifford or PCT '831 suggested that those skilled in the art at the time the invention was made would have known what type of particular metal and paper laminate would have been desirable for the laminates. It would have been obvious to shape the laminates of PCT '831 or Clifford using the operation defined in US Patent '774 to attain a non-planar shaped panel.

Response to Arguments

5. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 1733

The applicant is advised that those skilled in the art at the time the invention was made would have found it obvious to employ a die press to shape the panels to form vehicle panels with a paper core and metal skins (as was desired by PCT '831 or Clifford). Clearly use of the techniques of any one of Japanese Patent 11-151530, Japanese Patent 11-347642 or Onat et al would have been within the purview of the ordinary artisan.

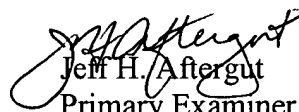
No claims are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 703-308-2069. The examiner can normally be reached on Monday-Friday 6:30-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Jeff H. Aftergut
Primary Examiner
Art Unit 1733

JHA
November 20, 2003